14. (Amended) The insert earphone of claim 8 further comprising an acoustic damper located in the rigid tube nipple proximate the first end of the rigid tube nipple.

15. (Amended) An insert earphone comprising:

a housing;

a receiver located in the housing and having an output port, the receiver for electrically coupling with an audio signal source;

a flexible eartip for acoustic sealing with ear canal of a user;

a tube nipple having a first end and a second end, the first end located within the housing and acoustically coupled to the output port of the receiver and the second end located externally to the housing and acoustically coupled to the flexible eartip; and

an acoustic damper located in the tube nipple proximate the first end of the tube nipple.

REMARKS

Claims 1-21 are pending in the above-identified application. Applicant acknowledges with appreciation the allowance of claims 15-21, and the statement that claims 2, 6, 11 and 14 would be allowable if rewritten in independent form.

Claims 8-9 and 12-13 presently stand rejected under 35 U.S.C. 102(e) as being anticipated by Iseberg et al. (U.S. Patent No. 5,887,070). In addition, 1, 3-5, 7 and 10 presently stand rejected under 35 under 35 U.S.C. 103(a) as being unpatentable over Iseberg et al. (U.S.

Patent No. 5,887,070) in view of Schiess et al. (U.S. 5,265,168). Applicant respectfully traverses these rejections.

As an initial matter, Applicant points out that 35 U.S.C. 102(e) requires that the prior art reference be "filed by another." However, the present application names the identical inventors, Wilson and Iseberg, as in the Iseberg et al. reference. Therefore, the Iseberg et al. reference cannot properly be used as a reference under 35 U.S.C. 102(e) against the present application, and thus also does not qualify as prior art under 35 U.S.C. 103(a). The above rejections should fall for this reason alone.

Nevertheless, Applicant requests that the Examiner consider Iseberg et al. as though it were a valid reference and consider the merits of Applicant's amendments and arguments, in case the device described in the Iseberg et al. reference qualifies as prior art under 35 U.S.C. 102(a) and/or 35 U.S.C. 102(b).

The Anticipation Rejection – Iseberg et al.

With regard to an anticipation rejection, MPEP 2131 states that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California,* 814 F.2d 628, 631 2 USPQ2d 1051, 1053 (Fed.Cir. 1987). MPEP 2131 also states that "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Regarding independent claim 8, Applicant submits that the Iseberg et al. reference lacks the limitation of "a rigid tube nipple " as specifically claimed by Applicant in amended claim 8.

Applicant has amended claim 8 to clarify that the rigid tube nipple of claim 8 "provide[s] an acoustic pathway through at least one wall of the housing" and that "the first end of the rigid tube nipple [is] located within the housing and [is] acoustically coupled to the output port of the receiver and the second end of the rigid tube nipple [is] located externally to the housing and [is] acoustically coupled to the flexible tube portion of the flexible eartip." Amended claim 8 is now similar to allowed claim 15. Attached hereto as Appendix A are copies of the claims that specifically identify the amendments made.

With regard to claims 12 and 13, Applicant also submits that Iseberg et al. lacks the limitation of a "flexible channel located between the output port of the receiver and the first end of the rigid tube nipple." Iseberg et al. discloses a receiver 18 having an output port 22 that fits directly into the inlet end portion 48 of passage 46 formed by tubular portion 35 of housing 20. (See Fig. 2; column 3, lines 34-36; and column 4, lines 36-40). No flexible channel is found between output port 22 and tubular portion 35, since they mate directly.

Based on the foregoing, Applicant believes that the rejection of claims 8-9 and 12-13 in view of Iseberg et al. has been overcome.

The Obviousness Rejection – Iseberg et al. in view of Schiess et al.

With regard to an obviousness rejection, MPEP 2142 states that in order for a *prima facie* case of obviousness to be established three basic criteria must be met. One criterion is that there must be some suggestion or motivation to combine the reference teachings, and another is that the reference or combinations of references must teach or suggest all the claim limitations.

With regard to the first criterion above, Applicant submits that there is no teaching in

either of the Iseberg et al. or Schiess et al. references to combine those references, or then modify their teachings as necessary to achieve Applicant's claimed invention. In addition, a person of ordinary skill in the art would never look to the Schiess et al. reference for assistance in designing an insert earphone. Specifically, the Schiess et al. reference discloses a housing that is shaped to fit behind an ear. FIG. 1 of Schiess et al. shows a carrying hook 4 that loops over the top of the ear for support of the hearing aid by the ear. The carrying hook does not fit into the ear canal of the hearing aid wearer, nor is the hearing aid supported by the ear canal. The design considerations for a device that is intended to be inserted into and hung from (i.e., supported by) the ear canal are completely different.

With regard to the second criterion above, Applicant submits that the combination of Iseberg et al. and Schiess et al. lacks the limitation of "a rigid tube nipple " as specifically claimed by Applicant in amended claim 1. Applicant has amended claim 1 to clarify that the rigid tube nipple of claim 1 "provide[s] an acoustic pathway through at least one wall of the housing" and that "the first end of the rigid tube nipple [is] located within the housing and [is] acoustically coupled to the output port of the receiver and the second end of the rigid tube nipple [is] located externally to the housing and [is] acoustically coupled to the flexible tube portion of the flexible eartip." Amended claim 1 is now similar to allowed claim 15. Again, attached hereto as Appendix A are copies of the claims that specifically identify the amendments made.

Based on the foregoing, Applicant believes that the rejection of claims 1, 3-5, 7 and 10 over Iseberg et al. in view of Schiess et al. has been overcome.

Finally, Applicant has amended the preamble of allowed claim 15 (see Appendix A).

Conclusion

Based on the foregoing, Applicant believes that claims 1-21 are in condition for allowance. If the Examiner disagrees, Applicant respectfully requests a phone interview, and requests that the Examiner telephone the undersigned. A Notice of Allowability is courteously solicited.

Applicant encloses herewith a Request for a One-Month Extension of Time, that authorizes that the associated fee be charged to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Respectfully submitted,

Date: November 12, 2001

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APPENDIX A

1. An insert earphone [for audiometric testing] comprising:

a housing;

a receiver located in the housing and having an output port, the receiver for electrically coupling with an audio signal source;

a flexible eartip for acoustic sealing with an ear canal of a user; and

a tube nipple providing an acoustic pathway through at least one wall of the housing and having a first end and a second end, the first end being located within the housing and being acoustically coupled to the output port of the receiver and the second end being located externally to the housing and being acoustically coupled to the flexible eartip, the tube nipple and housing being configured and arranged such that the angle between a longitudinal axis of the tube nipple and the vertical axis is obtuse.

6. The insert earphone of claim 1 [wherein the first end of the tube nipple is located within the housing and the second end of the tube nipple is located externally to the housing, and] further comprising an acoustic damper located in the tube nipple proximate the first end of the tube nipple.

8. An insert earphone [for audiometric testing] comprising:

a housing;

a receiver located in the housing and having an output port, the receiver for

electrically coupling with an audio signal source;

a flexible eartip for acoustic sealing with an ear canal of a user, the flexible eartip having a foam eartip portion and a flexible tube portion; and

a rigid tube nipple providing an acoustic pathway through at least one wall of the housing and having a first end and a second end, the first end of the rigid tube nipple being located within the housing and being acoustically coupled to the output port of the receiver and the second end of the rigid tube nipple being located externally to the housing and being acoustically coupled to the flexible tube portion of the flexible eartip.

14. The insert earphone of claim 8 [wherein the first end of the rigid tube nipple is located within the housing and the second end of the rigid tube nipple is located externally to the housing, and] further comprising an acoustic damper located in the rigid tube nipple proximate the first end of the rigid tube nipple.

15. An insert earphone [for audiometric testing] comprising:

a housing;

a receiver located in the housing and having an output port, the receiver for electrically coupling with an audio signal source;

a flexible eartip for acoustic sealing with ear canal of a user;

a tube nipple having a first end and a second end, the first end located within the housing and acoustically coupled to the output port of the receiver and the second end located externally to the housing and acoustically coupled to the flexible eartip; and

an acoustic damper located in the tube nipple proximate the first end of the tube nipple.